

REMARKS

This paper is responsive to an Office Action dated April 9, 2004. Prior to this amendment claims 1-45 were pending. After amending claims 1, 8, 10, 12, 23, 32, and 34, claims 1-45 remain pending.

In Section 1 of the Office Action claims 8, 12, and 34 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite. Specifically, the Office Action states that there is no antecedent basis for "the second endpoint" (claim 8) and "the group" (claims 12 and 34). In response, the claims have been amended to recite "a second endpoint" (claim 8) and "a group" (claims 12 and 34).

In Section 2 of the Office Action claims 1-9, 23-31, 35-36, and 38 have been rejected under 35 U.S.C. 102(b) as anticipated by Wahi et al. ("Wahi"; US 4,899,372). With respect to claims 1 and 23, the Office Action states that Wahi describes a lockout system where an external telephone is connected to a residence with a plurality of telephone extensions. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Wahi describes a conventional POTS type system where the lines to the central office are connected to telephone extensions (see the upper left hand corner of Fig. 1). Wahi's invention involves the use of blocking circuitry that is enabled through the use of two additional

electrical lines (y and b) that are connected to each extension (col. 3, ln. 28-40).

The invention of claims 1 and 23, however, recites a different kind of telephone system, a Home Network system that uses a gateway to convert between the external line format (such as POTS) and a digital Home Network format. To clarify the above-mentioned distinctions, claims 1 and 23 have been amended to recite the step of converting between the format used by the external lines and the Home Network format. This limitation was previously recited in claims 10 and 32.

Wahi does not describe a Home Network telephone system, or the use of a gateway to convert between formats. Since Wahi does not describe all the limitation of claims 1 and 23, he cannot anticipate. Claims 2-9, dependent from claim 1, and claims 24-31, 35-36, and 38, dependent from claim 23, enjoy the same distinctions from the cited reference and the Applicant respectfully requests that the rejection be removed.

In Section 3 of the Office Action claims 10-22, 32-34, 37, and 39-45 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Wahi, in view of Kung et al. ("Kung"; US 6,252,952). With respect to claims 10 and 32, the Office Action acknowledges that Wahi does not disclose a gateway, but states that Kung teaches the use of various gateways. The Office Action states that it would have been obvious for one of ordinary skill at the time of the invention to combine Wahi's POTS lockout system with Kung's modern environment. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As

stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Generally, Kung describes an Internet Protocol based network 120 that can be integrated to communicate with other network types such a POTS 160, ATM 185, and a residential gateway 300, among others (col. 3, ln. 21-33, see Fig. 1). The residential gateway 300, in turn, is connected to customer premise equipment (CPE) 102 such as televisions and telephones (col. 3, ln. 34-50). Kung states that the gateway 300 couples CPE 102 to the rest of the network 1 "using any suitable broadband communication mechanism" (col. 4, ln. 17-21).

With respect to the first *prima facie* requirement to support a case for obviousness, there appears to be no motivation to combine the references. That is, the references should only be combined for the purposes of an obviousness analysis if Kung suggests a means of modifying Wahi's POTS lockout system, so that it can used in conjunction with a residential gateway.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d

680, 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, it appears as if the references are used only because the combination covers both privacy and gateway functions, not out a motivation to combine. Alternately stated, there is no suggestion in the Kung reference that his residential gateway build upon Wahi, to support a gateway-enabled privacy mode. Rather, the suggestion to modify the cited prior art can only be supplied in retrospect, in light of the present invention.

Further, neither the combination of references, nor the Office Action, demonstrate that the modification of the cited prior art references points to the reasonable expectation of success in the present invention, which is the second *prima facie* requirement of the obviousness analysis. Even if Kung can be combined with Wahi, the combination does not show how a gateway can be used to selectively exclude bridges between Home Network endpoints and an external telephone lines. Wahi's invention only has application to an analog POTS system, and Kung supplies no residential gateway/CPE details "In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." *Beckman Instruments Inc. v. LKB Produker AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989), *aff'd without op*, 930 F.2d 37 (1991).

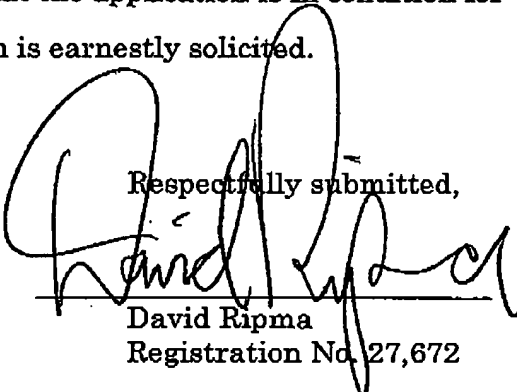
With respect to the third requirement to support a *prima facie* case of obviousness, the combination of references does not teach all the limitations of claims 1 and 23. Claims 1 and 23 recite the limitation of selectively excluding bridges between external telephone lines and Home Network endpoints. Kung does not teach any means of excluding bridges between his CPE and external lines. Wahi describes (y and b) wires that carry the controlling signal. "The controlling signal is the

global disconnect signal that tells *all* (emphasis added) extensions to which this device is connected to be disconnected from the phone line" (col. 3, ln. 31-36). Wahi shows no selective control over which extensions are disconnected. Thus, the combination of Wahi and Kung does not teach the selective bridge exclusion limitation of claims 1 and 23. Claims 10-22, dependent from claim 1, and claims 32-34, 37, and 39-45, dependent from claim 23, enjoy the same distinctions. Since the prior art references neither explicitly disclose nor suggest the claimed invention, the Applicant requests that the rejections be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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Respectfully submitted,


David Ripma
Registration No. 27,672

David Ripma, Patent Counsel
Sharp Laboratories of America, Inc.
5750 NW Pacific Rim Blvd.
Camas, WA 98607
Telephone: (360) 834-8754
Facsimile: (360) 817-8505
dripma@sharplabs.com